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Applicant: Cantor *et al.*

Serial No.: 09/880,988

Confirmation No.: 5954

Filed: : June 13, 2001

For: *USE OF NUCLEOTIDE ANALOGS IN
THE ANALYSIS OF OLIGONUCLEOTIDE
MIXTURES AND IN HIGHLY
MULTIPLEXED NUCLEIC ACID
SEQUENCING*

Art Unit: 1634

Examiner: Chakrabarti, Arun K.

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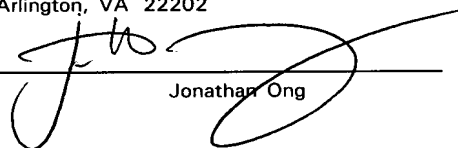
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Jonathan Ong

PETITION PURSUANT TO 37 C.F.R. §1.181

Commissioner for Patents
Arlington, VA 22202

w/B final

Dear Sir:

Applicant hereby submits a Petition pursuant to 37 C.F.R. §1.181 for reconsideration and removal of the finality of the Office Action, mailed October 4, 2002, in connection with the above-captioned application. This Petition is filed within two months of the mailing of the final rejection.

It is respectfully submitted that the Office Action mailed October 4, 2002, (hereinafter the Office Action), which was made final, introduces new grounds of rejection of claims 1-8, 10-20, 25-27, and 28-45 under 35 U.S.C. §103 that were not necessitated by amendment and that could have been applied in a previous Office Action. Therefore, the Action should not have been made Final.

For example, in the previous Office Action dated April 3, 2002, (hereinafter the previous Office Action), claim 1 and claims dependent thereon were rejected under 35 U.S.C. §103 as being unpatentable over Brennan (U.S. Patent 5,174,962) and Schulz (U.S. Patent 6,232,076 B1). Claim 1 and claims

U.S.S.N. 09/880,988

Cantor *et al.*

PETITION PURSUANT TO 37 C.F.R. §1.181

dependent thereon are now rejected under 35 U.S.C. §103 as being unpatentable over Brennan (U.S. Patent 5,174,962), Canard *et al.* (U.S. Patent 5,798,210), and Schulz (U.S. Patent 6,232,076 B1). Thus, a reference has been added to the rejection.

The addition of the Canard *et al.* reference constitutes a new rejection that is not necessitated by amendment because claim 1 was not amended in the response to the previous Office Action filed on September 10, 2002. One claim that is dependent on claim 1 (*i.e.* claim 4) was amended in the response to correct only minor typographical errors. Thus, to the extent that claim 1 and claims dependent thereon can be rejected, this new rejection could have been applied in the previous Office Action.

Similarly, claim 34 and claims dependent thereon were rejected under 35 U.S.C. §103 as being unpatentable over Brennan (U.S. Patent 5,174,962) and Shuber (U.S. Patent 5,888,778). Claim 34 and claims dependent thereon are now rejected under 35 U.S.C. §103 as being unpatentable over Brennan (U.S. Patent 5,174,962), Shuber (U.S. Patent 5,888,778), Canard *et al.* (U.S. Patent 5,798,210), and Schulz (U.S. Patent 6,232,076 B1). Thus, two references have been added to the rejection.

The addition of the Canard *et al.* and Schulz references constitutes a new rejection that is not necessitated by amendment because claim 34 and claims dependent thereon were not amended in the response to the previous Office Action filed on September 10, 2002. Thus, to the extent that claim 34 and claims dependent thereon can be rejected, this new rejection could have been applied in the previous Office Action.

Failure to withdraw the finality of the Office Action denies the Applicant the right to amend the claims, if needed, and/or provide arguments to overcome this rejection. Therefore, since the newly recited rejections of claims 1-8, 10-20, 25-27, and 28-45 under 35 U.S.C. §103 were not necessitated by

U.S.S.N. 09/880,988

Cantor *et al.*

PETITION PURSUANT TO 37 C.F.R. §1.181

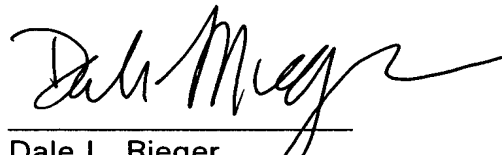
amendment and could have been raised in the previous Office Action, the finality of the Office Action is improper.

* * *

In light of the above remarks, reconsideration and removal of the finality of the Office Action are respectfully requested.

Respectfully submitted,
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